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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/658,551	09/08/2000	Craig Robert Jeffrey	1171/38910/79	3896

7590

08/13/2003

Trexler Bushnell Giangiorgi & Blackstone Ltd
105 W Adams St
Chicago, IL 60603

EXAMINER

PATEL, MITAL B

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 08/13/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

EC

Office Action Summary	Application No. 09/658,551	Applicant(s) JEFFREY ET AL.	
	Examiner Mital B. Patel	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 08 September 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4 and 13 is/are rejected.
- 7) ☒ Claim(s) 5-12 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 September 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>4</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Reference characters 113, 114, 120, 140, 142, and 164. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

3. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The

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disclosure concerns," "The disclosure defined by this invention," "The **disclosure** describes," etc.

Claim Objections

4. Claims 8-12 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claims. See MPEP § 608.01(n). Accordingly, the claims 8-12 have not been further treated on the merits.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1, 2, and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Brawn (US 3,972,326).

7. **As to claim 1**, Brawn teaches a pressure regulating device for use with a breathing assistance apparatus which conveys inhalatory gases to, and removes exhalatory gases from a patient requiring breathing assistance comprising a container **1, 20** which includes a body of liquid **9,24** terminal conduit means **4,33** including proximate and distal ends, the proximate end adapted for connection to a breathing assistance apparatus and in use accepting exhalatory gases therefrom, and the distal end submerged in the body of liquid, such that in use the mean pressure of the

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inhalatory gases supplied to a patient is adjusted by the level to which the distal end is submerged in the body of water.

8. **As to claim 2**, Brawn teaches a device further comprising a connection means attached to the container and engaging the terminal conduit means, whereby in use the terminal conduit means may be adjusted in axial position in predetermined increments, with respect to the connection means.

9. **As to claim 13**, Brawn teaches a pressure regulating device for use with a breathing assistance apparatus which conveys inhalatory gases to, and removes exhalatory gases from a patient requiring breathing assistance comprising a container **1, 20** which includes a body of liquid **9,24** terminal conduit means **4,33** including proximate and distal ends, the proximate end adapted for connection to a breathing assistance apparatus and in use accepting exhalatory gases therefrom, and the distal end submerged in the body of liquid, such that in use the resultant bubbling occurring in the body of liquid produces relatively small controlled perturbations in the pressure of inhalatory gases supplied to the patient.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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11. Claims 3 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brawn (US 3,972,326).

12. **As to claim 3**, Brawn teaches essentially all of the limitations except for wherein the terminal conduit means includes at least one partial groove and the connection means includes at least one matching partial resilient ridge or toggle. It should be noted that Brawn does teach that a friction fit connection rather than the type recited. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to make the terminal conduit means includes at least one partial groove and the connection means includes at least one matching partial resilient ridge or toggle because Applicant has not disclosed how the particular limitation solves a stated problem, is advantages over the prior art, or provides an unexpected result. One of ordinary skill in the art, furthermore, would have expected Applicant's invention to perform equally well with the friction fit since the connection between the two elements is still maintained.

13. **As to claim 4**, Brawn teaches essentially all of the limitations except for wherein the predetermined increments are one half centimeters each. Applicant has not disclosed how the particular limitation solves a stated problem, is advantages over the prior art, or provides an unexpected result. Furthermore, the particulars of the limitation are directed to the method of using the device and therefore, little or no patentable weight is given to the limitation. Additionally, it would have been obvious to one of ordinary skill in the art to make such predetermined increments depending on the intended therapy and patient.

Allowable Subject Matter

14. Claims 5-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 4011866 and US 2989069.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mital B. Patel whose telephone number is 703-306-5444. The examiner can normally be reached on Monday-Friday (8:00 - 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on 703-308-1957. The fax phone numbers for the organization where this application or proceeding is assigned are 703-306-4520 for regular communications and 703-306-4520 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

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mbp

August 8, 2003

A handwritten signature in black ink, appearing to read 'Weilun Lo', with a stylized, cursive script.

WEILUN LO
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3700